

REMARKS/ARGUMENTS

In the Office Action mailed December 8, 2010 (hereinafter, "Office Action"), claims 1, 2, 6, 8, and 9 stand rejected under 35 U.S.C. § 102. Claims 1-9 stand rejected under 35 U.S.C. § 103. Claim 1 has been amended.

Applicant respectfully responds to the Office Action.

I. Claims 1, 2, 6, 8, and 9 Rejected Under 35 U.S.C. § 102(b)

Claims 1, 2, 6, 8, and 9 stand rejected under 35 U.S.C. § 102b as being anticipated by U.S. Patent No. 2,277,615 to Townsend (hereinafter, "Townsend") or U.S. Patent No. 5,725,247 to Nilsson et al. (hereinafter, "Nilsson"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not disclose all of the subject matter in the claims.

Claim 1 has been amended to recite:

taking at least one initial universal beam;
determining a desired depth of a structural beam to be formed from the at least one initial universal beam and a width of material to be removed from the at least one initial universal beam to achieve the desired depth of the structural beam;
making a first cut generally longitudinally along the web of the or each initial universal beam on a first path, the web being generally rectangular in shape and having a first narrow edge and a second narrow edge opposite the first narrow edge, wherein the first cut extends from the first narrow edge to the second narrow edge;
making a second cut generally longitudinally along the web of the or each initial universal beam on a second path differing from the first path of the first cut to

form cut halves, wherein the second cut extends from the first narrow edge to the second narrow edge, wherein the first and the second cuts are spaced apart from each other and do not intersect at any point thereby defining the width of the material therebetween, the material extending from the first narrow edge to the second narrow edge;

separating the cut halves of the or each initial universal beam;
removing material between the first and second cut; and
welding the halves together to produce the structural beam of the desired depth.

Support for the subject matter added by amendment is provided, for example, at page 1, lines 18-23; page 2, lines 1-20; page 3, line 18 - page 4, line 16; and Figures 2-3 of the pending application.

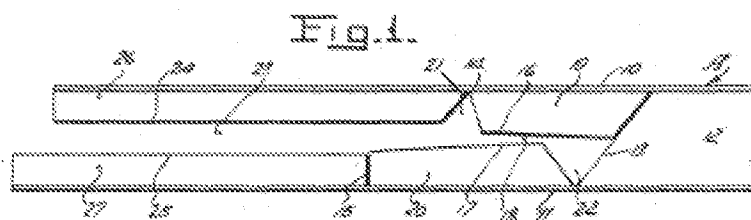
In particular, Applicant respectfully submits that neither Townsend nor Nilsson teach the following subject matter of amended claim 1:

making a first cut generally longitudinally along the web of the or each initial universal beam on a first path, the web being generally rectangular in shape and having a first narrow edge and a second narrow edge opposite the first narrow edge, *wherein the first cut extends from the first narrow edge to the second narrow edge*

(Emphasis added.) Further, amended claim 1 recites:

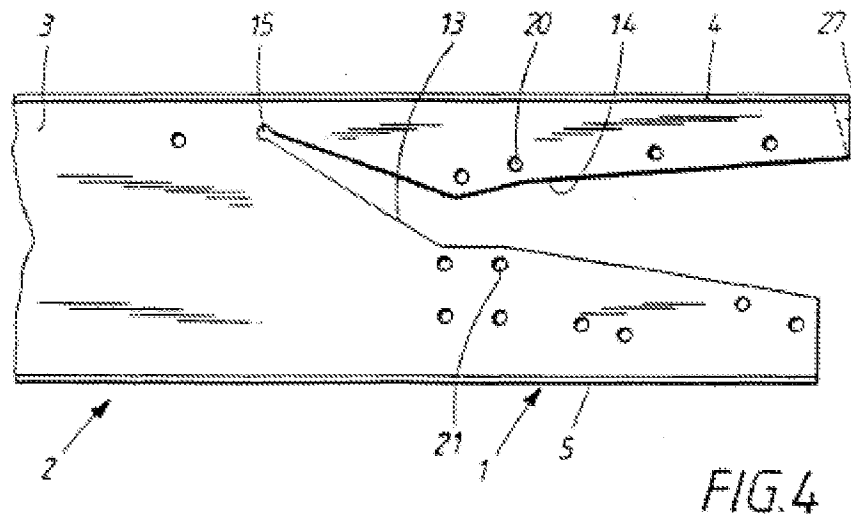
wherein the first and the second cuts are spaced apart from each other and do not intersect at any point thereby defining the width of the material therebetween, *the material extending from the first narrow edge to the second narrow edge.*

(Emphasis added.) Townsend teaches a cut that does not extend from a first narrow edge to a second narrow edge of the connecting web 12. For example, Figure 1 of Townsend (which is provided below) illustrates a cut that extends only partially across the connecting web 12 rather than extending from a first narrow edge to a second narrow edge of the web, as recited in amended claim 1.



As further illustrated in Figure 1 of Townsend, this reference also fails to teach first and second cuts that do not intersect and “the material [between the first and second cuts] extending from the first narrow edge to the second narrow edge [of the web],” as recited in amended claim 1.

Nilsson likewise fails to teach this subject matter. As illustrated, for example, in Figure 4 of Nilsson (which is provided below) Nilsson fails to teach or suggest “wherein the first cut extends from the first narrow edge to the second narrow edge” of the web. Like Townsend, the cut of Nilsson extends only partially across the upright web 3.



As further shown in Figure 4 of Nilsson, this reference also fails to teach first and second cuts that do not intersect and “the material [between the first and second cuts] extending from the first narrow edge to the second narrow edge,” as recited in amended claim 1. Once again, this is because the cut of Nilsson does not traverse the disclosed web 3.

Accordingly, Applicant respectfully submits that neither Townsend nor Nilsson teach the subject matter of amended claim 1.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Townsend. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Townsend does not disclose all of the subject matter of claim 1.

Claims 2, 6, 8, and 9 depend from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2, 6, 8, and 9 be withdrawn.

II. Claims 1, 3-5, 8, and 9 Rejected Under 35 U.S.C. § 103(a)

Claims 1, 3-5, 8, and 9 stand rejected under 35 U.S.C. § 103a as being unpatentable over U.S. Patent No. 4,894,898 to Walker (hereinafter, “Walker”). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, “obviousness requires a suggestion of all limitations in a claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at **37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in the claims.

Claim 1 has been amended to recite “*determining . . . a width of material to be removed from the at least one initial universal beam to achieve the desired depth of the structural beam . . . wherein the first and the second cuts are spaced apart from each other and do not intersect at any point thereby defining the width of the material therebetween, the material extending from the first narrow edge to the second narrow edge.*” (Emphasis added.)

Applicant respectfully submits that Walker fails to teach or suggest at least this subject matter of amended claim 1. The first and second cuts illustrated in Walker intersect at least at one point in each embodiment within this reference whereas the first and second cuts do not intersect at any point

within the subject matter of amended claim 1. (*See, e.g.*, Figures 1B, 2B, 3B, 4B and 5B of Walker.)

In addition, Applicant respectfully submits that this intersection is evidenced by the separate part numbers referencing separate areas of material to be removed in the Walker reference. (*See, e.g.*, reference numbers 22 and 23 of Figure 1B of Walker.) Accordingly, Applicants respectfully submit that Walker fails to teach or suggest “determining . . . a width of material to be removed from the at least one initial universal beam to achieve the desired depth of the structural beam . . . the material extending from the first narrow edge to the second narrow edge,” as recited in amended claim 1.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Walker. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Walker does not teach or suggest all of the subject matter of amended claim 1.

Claims 3-5, 8 and 9 depend from amended claim 1. Accordingly, Applicant respectfully request that the rejection of claims 3-5, 8 and 9 be withdrawn.

III. Claim 7 Rejected Under 35 U.S.C. § 103(a)

Claim 7 stand rejected under 35 U.S.C. § 103a as being unpatentable over Walker in view of U.S. Patent No. 3,066,394 to Litzka (hereinafter, “Litzka”). This rejection is respectfully traversed.

The standard for nonobviousness is set forth above.

As indicated above, claim 1 is allowable over the cited references. Claim 7 depends from claim 1. Accordingly, Applicant respectfully request that the rejection of claim 7 be withdrawn.

IV. Claims 1, 2, 6, 8, and 9 Rejected Under 35 U.S.C. § 103(a)

Claims 1, 2, 6, 8, and 9 stand rejected under 35 U.S.C. § 103a as being unpatentable over U.S. Patent No. 4,586,646 to Booher (hereinafter, “Booher”) in view of Townsend. This rejection is respectfully traversed.

The standard for nonobviousness is set forth above.

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in the claims.

As stated above, in particular, Applicant respectfully submits that neither Townsend nor Nilsson teach the following subject matter of amended claim 1:

making a first cut generally longitudinally along the web of the or each initial universal beam on a first path, the web being generally rectangular in shape and having a first narrow edge and a second narrow edge opposite the first narrow edge, *wherein the first cut extends from the first narrow edge to the second narrow edge*

(Emphasis added.) Further, amended claim 1 recites:

wherein the first and the second cuts are spaced apart from each other and do not intersect at any point thereby defining the width of the material therebetween, *the material extending from the first narrow edge to the second narrow edge.*

(Emphasis added.)

As explained above, Townsend fails to teach or suggest this subject matter and teaches only a partial cut across the web 12 of the beam illustrated therein.

Booher fails to address the inadequacies of Townsend. Booher teaches a method for “I-beam fabrication” using “two distinct T-shaped beam portions.” (Booher, Abstract.) The two distinct T-shaped beam portions are secured together using a welding carriage assembly 52. (Booher, col. 4, lines 10-16.) The two distinct T-shaped beam portions are not disclosed as being formed by cutting an I-beam. Instead, the two distinct T-shaped beam portions are merely provided without explanation. (For example, the two distinct T-shaped beam portions could be independently fabricated in a T-shape rather than being cut.) Thus, while the T-shaped beam portions are discussed at various locations within Booher (Abstract; col. 2, line 67-col. 3, line 5; col. 3, lines 12-22; col. 4, lines 10-21), there is no teaching or suggestion of “the first and the second cuts [being] spaced apart from each other and . . . not intersect[ing] at any point thereby defining the width of the material therebetween, the material extending from the first narrow edge to the second narrow edge [of the web],” as recited in amended claim 1.

Further, while Booher discloses removing portions at reference numbers 72 and 73 of the “T-shaped beam portions,” these portions extend across only a part of the web portion 51 and thus do not comprise “material extending from the first narrow edge to the second narrow edge [of the web],” as recited in amended claim 1.

Appl. No. 10/580,644
Amdt. dated May 9, 2011
Reply to Office Action of December 08, 2010

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Booher in view of Townsend. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Booher does not teach or suggest all of the subject matter of claim 1.

Claims 2, 6, 8, and 9 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully request that the rejection of claims 2, 6, 8, and 9 be withdrawn.

Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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Date: May 9, 2011

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